

TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

78 325486

Mailed: January 28, 2010

Cancellation No. 92051963

Slyvester Stewart, pka Sly
Stone, d/b/a Sly and the
Family Stone

v.

Even St. Productions, Ltd.


Amy Matelski, Paralegal Specialist

The notice instituting this proceeding and a copy of
the petition to cancel were forwarded to registrant but
were returned by the Postal Service as undeliverable.

This Office has since ascertained a more recent
address that service upon registrant could be effected and
would be accepted when documents are mailed as follows:

Even St. Productions Ltd.
11845 W. Olympic Blvd, Suite 1085
Los Angeles, CA 90064

Jay Coggan
Agent for Service of Process
of Even St. Productions Ltd.
1925 Century Park E. Suite 2320
Los Angeles, CA 90067


03-29-2010

Accordingly, the above notice, with enclosure, is remailed as indicated above.

Registrant is allowed until **FORTY DAYS** from the mailing date of this order in which to inform this Office of its correct address in order that all records may be amended. Compliance with Trademark Rule 2.193(b) and Trademark 2.119(a) is required.

If there has been any transfer of interest in the involved registration, registrant must so advise the Board and registrant must submit copies of the appropriate documents. See Section 10 of the Trademark Act and Patent and Trademark Rules 3.71 and 3.73.

In view of the circumstances, the time for filing an answer to the petition to cancel is extended to **FORTY DAYS** from the mailing date of this order. Notice is hereby given that unless the registrant listed herein, its assigns or legal representatives, shall enter an appearance, answer or other response to the petition within the time frame allowed, the cancellation may proceed as in the case of default.

In accordance with the Trademark Rules of Practice, conferencing, disclosure, discovery and testimony dates are set below. In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits,

must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Time to Answer	3/9/10
Deadline for Discovery Conference	4/8/10
Discovery Opens	4/8/10
Initial Disclosures Due	5/8/10
Expert Disclosures Due	9/5/10
Discovery Closes	10/5/10
Plaintiff's Pretrial Disclosures	11/19/10
Plaintiff's 30-day Trial Period Ends	1/3/11
Defendant's Pretrial Disclosures	1/18/11
Defendant's 30-day Trial Period Ends	3/4/11
Plaintiff's Rebuttal Disclosures	3/19/11
Plaintiff's 15-day Rebuttal Period Ends	4/18/11

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

ESTTA Tracking number: **ESTTA327188**Filing date: **01/15/2010**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Slyvester Stewart		
Entity	Individual	Citizenship	UNITED STATES
Address	22917 Pacific Coast Hwy., #350 Malibu, CA 90265 UNITED STATES		

Attorney information	Rod Rummelsburg Allan Law Group, P.C. 22917 Pacific Coast Hwy., #350 Malibu, CA 90265 UNITED STATES rod@rjallanlaw.com Phone:310-456-3024
----------------------	--

Registration Subject to Cancellation

Registration No	2920734	Registration date	01/25/2005
Registrant	Even St. Productions, Ltd. 276 Fifth Avenue, Suite 507 New York, NY 10001 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 1967/10/09 First Use In Commerce: 1967/10/09 All goods and services in the class are cancelled, namely: musical sound recordings
Class 016. First Use: 1967/10/09 First Use In Commerce: 1967/10/09 All goods and services in the class are cancelled, namely: posters
Class 041. First Use: 2003/02/00 First Use In Commerce: 2003/02/00 All goods and services in the class are cancelled, namely: providing a website on a global computer network featuring information on a musical group and its sound recordings, video recordings, and photos

Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SLY AND THE FAMILY STONE		
Goods/Services	Musical performances, musical sound recordings.		

Attachments	Petition for Cancellation of Sly & Family Stone.pdf (6 pages)(362446 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/allanlaw3/
Name	Rod Rummelsburg
Date	01/15/2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SYLVESTER STEWART, an
individual, pka **SLY STONE**,
dba, **SLY AND THE FAMILY
STONE**,

Petitioner,

vs.

**EVEN ST. PRODUCTIONS
LTD.**, a New York corporation.

Respondent.

PETITION FOR CANCELLATION

Cancellation No.: _____

Registration No.: 2,920,734

Date of Issue: January 25, 2005

Petitioner, SYLVESTER STEWART, professionally known as SLY STONE, doing business as SLY AND THE FAMILY STONE ("Petitioner"), an individual who resides in Los Angeles County, California, c/o Allan Law Group P.C., 22917 Pacific Coast Highway, Suite 350, Malibu, CA 90265, believes he will be damaged by Registration No. 2,920,734, and hereby petitions to cancel the same.

Description of Respondent's Registration: Filed on November 10, 2003 for the mark SLY AND THE FAMILY STONE, registered on the Principal Register, in international class 9 for musical and sound recordings, claiming first use on October 9, 1967; international class 16 for posters, claiming first use on December 9, 1967; and international class 41 for providing a website on a global computer network featuring information on a

musical and sound recordings, video recordings and photos, claiming first use on or about February 1, 2003.

As grounds for this Petition, it is alleged that:

(Cancellation Based on Fraud)

1. Petitioner is informed and believes and thereon alleges EVEN ST. PRODUCTIONS LTD.'s ("Respondent") registration was obtained fraudulently in that in the formal application papers filed by Respondent under oath and notice of 18 U.S.C. 1001 in that it was stated "he/she is properly authorized to execute this application on behalf of the applicant," "he/she believes applicant to be the owner of the trademark or service mark sought to be registered," and "he/she believes applicant to be entitled to use such mark in commerce." Further Respondent stated "to the best of his/her knowledge and belief no other person . . . has the right to use the above-identified mark in commerce."

Petitioner is informed and believes and thereon alleges said statements were false in that as of the date the declaration was signed, on November 7, 2003, Respondent had no right to register or use the mark SLY AND THE FAMILY STONE. To the extent Respondent ever had any right to the use of the mark SLY AND THE FAMILY STONE, it would be in connection with an employment agreement, which included an assignment incorporated into and integrated with the employment agreement, between Respondent, formerly known as Stone Fire Productions, Ltd., and Petitioner, SYLVESTER STEWART, signed on or about February 27, 1989 ("Employment Agreement"), said Employment Agreement having a term of five (5) years. At the time Respondent filed the application papers on or about November 10, 2003, Respondent had no right to use or register the mark SLY AND THE FAMILY STONE, such right having expired at least nine (9) years earlier, if such right ever existed at all.

Petitioner is informed and believes and thereon alleges the above-cited statements from the application papers filed by Respondent under oath and notice of 18 U.S.C. 1001 were made by an authorized agent of Respondent, namely Respondent vice president Glenn Stone, with the knowledge and belief said statements were false. Petitioner is informed and believes and thereon further alleges said false statements were made with the intent to induce authorized agents of the U.S. Patent and Trademark Office (“USPTO”) to grant said registration. Reasonably relying upon the truth of said false statements, the USPTO did, in fact, grant said registration to Respondent.

Petitioner is informed and believes and thereon alleges Respondent further misrepresented to the USPTO that Respondent was the owner of the specimens submitted by the Respondent in Respondent’s application for the mark SLY AND THE FAMILY STONE. Petitioner is informed and believes and thereon alleges at the time Respondent submitted its trademark application to the USPTO, Respondent knew the specimens were not owned by Respondent, and such false information was provided by Respondent to the USPTO with the intent to induce the authorized agents of the USPTO to grant said registration. Reasonably relying upon the truth of said false representation, the USPTO did, in fact, grant said registration to Respondent.

Petitioner was damaged by said false statements of a registration issued in reliance thereon in that Petitioner since 1967 has continuously used the mark SLY AND THE FAMILY STONE in connection with live performances, musical sound recordings, and the Internet. Petitioner’s continued and legal use of said mark will be impaired by the continued registration of said mark by Respondent.

Petitioner first become aware of Respondent’s trademark registration in approximately February 2009, after Respondent’s attorney Jay Coggan sent a cease and desist letter dated January 29, 2009 (“Coggan Letter”) to

That's Entertainment International for the apparent purpose of trying to prevent Sly and the Family Stone band members Jerri Martini and Cynthia Robinson from performing under the name The Family Stone Project. The Coggan Letter stated and alleged Respondent is the owner of the service mark/trademark SLY AND THE FAMILY STONE.

(Cancellation Based on Prior Use of the Same Mark)

2. Petitioner hereby repeats, realleges, and incorporates by this reference, each and every allegation from each and every paragraph before and after this paragraph, as though said paragraphs were set forth in full herein.

Petitioner has performed publicly under the name Sly and The Family Stone since December 16, 1966. Since September 1, 1967 Petitioner has been and is now using the service mark SLY AND THE FAMILY STONE in connection with musical sound recordings. Said use has been valid and continuous since the date of first use and has not been abandoned. Said mark SLY AND THE FAMILY STONE of Petitioner is symbolic of extensive good will and consumer recognition built up by Petitioner through a substantial amount of time and effort in advertising, and national and international performing and promotion. The public has associated musician, performer and producer Sly Stone, the Petitioner, with the service mark SLY AND THE FAMILY STONE.

(Cancellation Based on Lanham Act §2(a))

3. Petitioner hereby repeats, realleges, and incorporates by this reference, each and every allegation from each and every paragraph before and after this paragraph, as though said paragraphs were set forth in full herein.

Petitioner since December 16, 1966 has been using the service mark SLY AND THE FAMILY STONE in connection with musical performances, and since September 1, 1967. Petitioner has been and is still using the service mark SLY AND THE FAMILY STONE in connection with sound recordings, which have been and/or still are featured and/or promoted in numerous media, including live performances, television, motion pictures, radio, Internet, posters, DVD, and album covers. Said use has been valid and continuous since the date of first use. The service mark SLY AND THE FAMILY STONE has become a famous mark, and the relevant class of the public has come to associate said service mark with Petitioner. For example, Petitioner's music group Sly and The Family Stone was inducted into the Rock and Roll Hall of Fame in 1993. The nationally and/or internationally televised 2006 Grammy awards show paid tribute to Sly and The Family Stone, and Petitioner performed on the show.

In view of the Respondent's registered mark, which is similar if not identical to Petitioner's designation, and in view of the related uses therefore, it is alleged that Respondent's registered mark consists of and comprises matter which is deceptive, falsely suggests a connection with Petitioner, and may disparage Petitioner.

(Cancellation Based on Ownership of Mark)

4. Petitioner hereby repeats, realleges, and incorporates by this reference, each and every allegation from each and every paragraph before and after this paragraph, as though said paragraphs were set forth in full herein.

Petitioner since December 16, 1966 has been using the service mark SLY AND THE FAMILY STONE in connection with musical performances, and since September 1, 1967 Petitioner has been and is still using the service mark SLY AND THE FAMILY STONE in connection

with sound recordings. Petitioner is the rightful owner of said common law service mark.

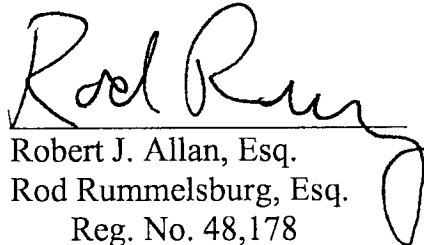
Respondent was not even in existence at the time Petitioner was first using the service mark SLY AND THE FAMILY STONE in interstate and international commerce. Petitioner is informed and believes and thereon alleges Respondent was not formed until over twenty (20) years later, on or about January 26, 1989, when Respondent incorporated in New York.

In view of the identical marks and the related nature of the goods and services of the respective parties, it is alleged Respondent's registered mark so resembles Petitioner's mark as to be likely to cause confusion, mistake, or deception to the consumer.

WHEREFORE, Petitioner prays that Registration No. 2,920,734 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

Dated: January 15, 2010

By:


Robert J. Allan, Esq.
Rod Rummelsburg, Esq.
Reg. No. 48,178

Allan Law Group, P.C.
22917 Pacific Coast Hwy., #350
Malibu, CA 90265
Tel: (310) 456-3024
Fax: (310) 317-0484
Attorneys for Petitioner
Sylvester Stewart/pka Sly Stone

Commissioner for IR

P.O. Box 1451

Alexandria, VA 22313-1451

If Undeliverable Return in Ten Days

OFFICIAL BUSINESS

PENALTY FOR PRIVATE USE, \$300

AN EQUAL OPPORTUNITY EMPLOYER



02 1M
0004244562
MAILED FROM ZIP CODE 22314



\$01.22

JAN 29 2010

51967
WEST PRODUCTIONS, LTD.
18 W. OLYMPIC BLVD
LOS ANGELES, CA 90064